Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-14, 17-20 and 22-25 are pending in the application, with claims 1 and 24 being the independent claims. Claim 15 is sought to be canceled without prejudice to or disclaimer of the subject matter therein. Applicants reserve the right to file divisional or continuation applications to the canceled subject matter. This amendment is believed to introduce no new matter, and entry thereof is respectfully requested under 37 C.F.R. § 1.116(b).

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Applicants' representative thanks the Examiner for the courtesies extended during the telephone interview on September 22, 2005. During the interview, Applicant's representative argued that the Examiner's rejections relied on impermissible hindsight based on Applicants' disclosure, and, as such, were improper. The Examiner requested that Applicant file a response to the outstanding Office Action so that the Examiner could reconsider the current rejections.

Rejections under 35 U.S.C. § 112

Claim 15 was rejected under 35 U.S.C. § 112, second paragraph. *See* Office Action, Sections 3 and 4. In furtherance of prosecution, and not in acquiescence of the

rejection, by the above amendment, claim 15 has been canceled. Applicants submit the rejection is now moot and request that it be withdrawn.

Rejections under 35 U.S.C. § 103

A. Rejection of claims 1-4, 6-14, 17-20 and 21-23

Claims 1, 3, 4, 6, 15, 17, 19, 22 and 23 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Unexamined Patent Application Publication 59-083772-A (the '772 publication). *See* Office Action, Section 6. Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness the references, alone, or in combination, must teach or suggest all claim limitations. M.P.E.P. § 2142. Any teaching or suggestion used to arrive at Applicants' invention must come from the prior art, and not Applicants' disclosure using impermissible hindsight. *Id.* "The examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *Teleflex, Inc. v. KSR International*, No. 04-1152, slip op. at 6 (CAFC Jan. 6, 2005).

Claim 1 is directed to a method for producing an electrode for a capacitor from a foil by applying a laser beam to a portion of the foil to create a wave pattern on the foil and etching the foil. In contrast to the claimed invention, the '772 publication does not teach applying a laser beam to create a wave pattern on a foil. Furthermore, there is no motivation or suggestion in the '772 publication for creating a wave pattern on a foil.

The Examiner is of the opinion that it would have been obvious to one of ordinary skill in the art to modify the '772 publication to select a wave pattern through routine experimentation. *See* Office Action, Section 6. Applicants respectfully disagree.

The Examiner does not cite to any portion of the '772 publication that discloses or suggests creating a wave pattern on a foil. Rather, the '772 publication appears to teach a method of forming non-wavy or straight lined patterns on a foil prior to etching. The '772 publication appears to teach that such straight lined patterns can consist of lines which are parallel or perpendicular to the longitudinal direction, i.e. the rolling direction, of the foil, or are oriented diagonally along the foil. *See* English Translation of the '772 publication at p. 4. The '772 publication also appears to teach that such patterns can consist of straight lines made to cross with each other to form an X. *Id.* Further, with respect to optimizing the straight lined patterns disclosed in the '772 publication, the '772 publication appears to teach that the width of the lines, the spacing of the lines or their position can be modified. *Id.* However, there is no disclosure or suggestion in the '772 publication of modifying the shape of the pattern lines. Therefore, while one of ordinary skill in the art might experiment with the width, spacing or position of the straight lines of the patterns disclosed in the '772 publication, there is no motivation for one of ordinary skill in the art to vary the shape of the pattern lines, as the Examiner has suggested.

The '772 publication fails to explicitly teach the step of claim 1 of applying a laser to create a wave pattern on a foil. In addition, the '772 publication fails to suggest modifying the straight lined patterns disclosed therein in any way other than the line width, spacing or position. Therefore, changing the shape of the straight lined patterns from straight lined patterns to wavy patterns cannot be considered as routine

experimentation. Rather, it appears that the Examiner has used impermissible hindsight to arrive at the claimed invention, by combining the elements of the '772 publication with Applicants' specification. The motivation and/or suggestion to modify the '772 publication cannot come from Applicants' disclosure.

Because the '772 publication fails to teach or suggest the step of claim 1 of applying a laser to create a wave pattern on a foil, claim 1, and claims 3, 4, 6, 17, 19, 22 and 23 which depend therefrom, are patentable over the '772 publication. Applicants respectfully request that the rejection of claims 1, 3, 4, 6, 17, 19, 22 and 23 be withdrawn.

Claim 2 has been rejected under 35 U.S.C. § 103(a) as unpatentable over the '772 publication in view of the English Abstract of Japanese Unexamined Patent Application Publication 02-075155-A (the '155 application). Office Action, Section 7. Claims 7-11 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the '772 publication in view of U.S. Patent No. 5,715,133 to Harrington *et al.* ("the '133 patent"). Office Action, Section 9. Claim 18 has been rejected under 35 U.S.C. § 103(a) as unpatentable over the '772 publication in view of U.S. Patent No. 3,779,877 to Alwitt ("the '877 patent"). Office Action, Section 10. Claim 20 has been rejected under 35 U.S.C. § 103(a) as unpatentable over the '772 publication in view of U.S. Patent No. 4,481,084 to Chen *et al.* ("the '084 patent") and "A New Coating Process for Aluminum" by Patel *et al.* ("the Patel reference") Office Action, Section 11. Claims 7-11, 18 and 20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the '772 publication in view of U.S. Patent No. 6,802,954 to Hemphill *et al.* ("the '954 patent). Office Action, Section 12. Claim12 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over the '772 publication in view of the English language abstract of

Japanese Unexamined Patent Application Publication 07-049428-A ("the '428 abstract"). Office Action, Section 13. Claims 13 and 14 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the '772 publication in view of the '428 Abstract (Constitution) ("the '428 abstract") as applied to claim 12, above, and further in view of U.S. Patent Application Publication 2002/0111029 to Johnson ("Johnson "). Office Action, Section 14.

Applicants respectfully traverse the above rejections.

As discussed above, absent impermissible hindsight gleaned from Applicants' invention disclosure, there is no suggestion or motivation to modify the teaching of the '772 publication to replace the straight line patterns disclosed therein with a wave pattern as claimed. Changing the shape of the straight lined patterns disclosed in the '772 publication to a wave pattern as claimed cannot be considered routine experimentation. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992).

For at least this reason, independent claim 1 and claims 2, 7-14, 18 and 20, which depend from claim 1, are patentable. Applicants respectfully request that the rejection of claims 1, 2, 7-14, 18 and 20 be withdrawn.

B. Rejection of claims 5, 24 and 25

Claims 5, 24 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the '772 publication further in view of the English Abstract of

Japanese Patent Application Publication 04-056309-A (the '309 abstract). Office Action, Section 8. Applicants respectfully traverse this rejection.

A *prima* facie case of obviousness requires that each and every claim limitation be taught or suggested in the prior art, and that there be motivation or suggestion for combining reference teachings. M.P.E.P. § 2142 (May 2004). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. *Id.* Applicants respectfully submit the Examiner has not properly established a *prima facie* case of obviousness for claims 5, 24 and 25 because there is no motivation to combine the cited references, other than that provided by Applicants' specification.

Independent claim 24 is directed to a method in which a laser is applied to a foil to create a pattern after the etching step. Similarly, claim 5, which depends from claim 1, is also directed to a method of applying a laser to a foil to create a pattern after etching the foil. As disclosed at page 11 of the application as filed, in one embodiment of the present invention, a foil is first etched and then a pattern is applied to the etched foil using a laser, such that the pattern in the foil forms areas of strength to prevent propagation of cracks. None of the cited references provide motivation or suggestion for a process in which a laser is applied to the foil to create a pattern after the etching step, as claimed.

Neither the '309 abstract nor the '772 publication teach applying a laser to a foil after etching to create a pattern. While the '309 abstract appears to teach applying a laser to a foil after an etch process, the '309 abstract appears to teach applying the laser to a foil to form a barrier layer of oxide on the foil. *See* the '309 abstract at p. 1-2. The '309 abstract does not disclose or suggest creating a pattern on the foil with a laser. While the

'772 publication appears to teach using a laser to create a pattern on a foil, the '772 publication requires that the laser beam be applied to the foil before etching, to retard or prevent etching the foil where the laser was applied. *See* English Translation of the '772 publication at p. 3. Combining the references as the Examiner has suggested, to arrive at the claimed invention, would destroy this teaching of the '772 publication. As such, the cited references teach away from the combination suggested by the Examiner.

For at least this reason, claim 5 and independent claim 24 and claim 25, which depends therefrom, are patentable. Applicants respectfully request that the rejection be withdrawn.

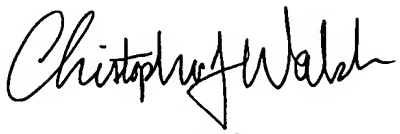
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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